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10/674,653	09/30/2003	Marc E. Feinberg	ETH5092 [13926]	4786
25570	7590	12/23/2011	EXAMINER	
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C. Intellectual Property Department P.O. Box 10064 MCLEAN, VA 22102-8064			RYCKMAN, MELISSA K	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/674,653  
Filing Date: September 30, 2003  
Appellant(s): FEINBERG, MARC E.

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Michael J. Mlotkowski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/27/11 appealing from the Office action  
mailed 4/27/11.

**(1) Real Party in Interest**

A Statement identifying by name the real party of interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:  
Claims 3-6,8,14,21,22 and 27-50 are pending. Claims 3,4,14,21,22,27-37,43-45,49 and 50 are withdrawn. Claims 5,6,8,38-42 and 46-48 are rejected.

**(4) Status of Amendments After Final**

The appellant's statement of the status of the amendments is incorrect, the claims attached to the appeal brief do not contain the correct language for claim 38. The claims dated 9/6/11 have not been entered. Claim 38 (dated 9/6/11) raises new grounds of rejection, the correct version of claim 38 is in the claims dated 2/12/10.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

Every ground of rejection as set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is incorrect. Claim 38 contains an unentered amendment. The correct version of claim 38 is found in the claim set dated 2/12/10.

**(8) Evidence Relied Upon**

4724838	Hasson	2-1988
6394951	Taylor	6394951

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 38-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Line 17 of Claim 38 states "the connector is a rotatable connector", the

current specification and current drawing do not enable this, the connector as shown in the drawings, is element 139 in Fig. 7, element 139 does not rotate as it is fixed to the arm.

Claims 5, 6, 8, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasson (US 4724838), and further in view of Taylor et al. (US 6394951).

Regarding Claims 8 and 46, Hasson teaches a tissue approximation device comprising two elongate arms (54, Fig. 7), an attachment means (56) to secure the elongate arms to each other at one or more locations, pads (24, pad is defined in the World English Dictionary as any of various level surfaces of flat-topped structures) movably connected (move via the ball and socket (301, 302, Fig. 14) on at least a portion of the elongate arms to anchor the tissue approximation device to the tissue, and a locking means (64) to lock the elongate arms in place relative to each other, wherein (i) the pads are spaced apart from the one or more locations of the attachment means (56) in the direction of the elongate arms (the pads 24 are spaced apart from 56 in the direction of the arms), and (ii) the tissue approximation device has an open (when moving 62 it opens and closes, Fig. 7) and a closed position, and when in the closed position, the pads are parallel and non-contiguous to each other (fig. 7, the pads are not touching when closed). The pad has a second surface that is rotatably coupled to the distal end of each of the elongate arms by a ball and socket connector (301,302, col. 5, II. 11,12), wherein the second surface as a socket (302) and the distal end of the

elongate arms has a ball (301), the pad is rotatable about the ball and socket connector about at least two axes (col. 5, ll. 15-18).

Hasson teaches the claimed invention but fails to specify the pad being an adhesive pad. However, Taylor teaches using an adhesive surface (col. 14, ll. 15-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the adhesive surface of Taylor with the pads of Hasson, as the adhesive aids in securing the device during the procedure.

Regarding Claim 5, Hasson teaches the tissue approximation device of claim 1, wherein the elongate arms (54) form a pair of forceps, the attachment means (56) is a yoke on the forceps (Fig. 7), and the locking means (64) is a ratchet mechanism on the forceps (Fig. 7).

Regarding Claim 6, Hasson teaches the tissue approximation device of claim 5, wherein the distance between the elongate arms is adjustable by means of a ratchet mechanism (64).

Regarding claim 47, Hasson teaches the claimed invention including a ball and socket connector, however does not specify the second surface has the ball and the distal end has the socket. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the device to have the second surface have the socket and the distal end have the ball, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding Claim 48, Hasson teaches the second surface and the distal end of the elongate arm connect in a snap fit manner (col. 5, ll. 11-18).

**(10) Response to Argument**

It is noted claims dated 9/6/11 have not been entered and the most recent claim set was filed on 2/12/10.

Regarding claims 38-42: The Appellant argued that the 112 rejection should be withdrawn based on the claim amendment, however, the amendment was not entered and the rejection is maintained.

Regarding claim 8: The Appellant argues Hasson fails to teach the device wherein when in the closed position the pads are non-contiguous to each other. The examiner's response is that the claims do not state what the closed position consists of (for further clarification, the application does not define the closed position by stating, for example, that "the device is in the closed position when it is locked by the locking means" and even if this was the case when element 64 in Fig. 7 is locked on the first tab the pads are non-contiguous). The device of Hasson would be considered "closed", for example, when fully engaged with tissue and in this instance the pads are non-contiguous to each other because the tissue is between them.

Regarding claim 46: The Appellant argues Hasson does not have "the second surface has the socket and the distal end (of the elongate arm) has the ball". The examiner points to Fig. 14 and col. 5, ll. 11, element 301 is the ball that is mounted onto

12 (the distal end of the elongate arm) and the socket 302 is on the second surface via element 303, in Fig. 14.

Regarding claim 47: The Appellant argues it would not have been obvious to rearrange the ball and socket in the device. The examiner maintains the rejection above. The specification (page 3, ll. 1-4) of the current application lists various embodiments including rearranging the ball and socket location. There is no advantage in the specification associated with the placement of the ball and socket.

Regarding claim 48: The Appellant argues Hasson fails to teach the ball and socket are snap-fit. The examiner's position is the act of putting the ball into the socket is snap-fitting the two together. In addition, the spring 305 in Fig. 14 aids in the snap fit of the ball and socket together. The claim does not provide structure for "snap fit" and Hasson teaches the structural limitations required by the claim.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Melissa Ryckman

/Melissa Ryckman/

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